



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/807,701 | 03/23/2004 | Gadiel Seroussi | 200309194-1 | 5596 |
| 22879 7590 12/17/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400 | | | | |
| EXAMINER | | | | |
| ALHJ/A, SAIF A | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2128 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 12/17/2008 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM

mkraft@hp.com

ipa.mail@hp.com

Office Action Summary

Application No.

10/807,701

Applicant(s)

SEROUSSI, GADIEL

Examiner

SAIF A. ALHIJA

Art Unit

2128

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) 21-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 21-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-12, 17-26 have been presented for examination.

Claims 21-26 were non-elected following restriction.

Claims 13-16 have been cancelled.

Claims 1-12, and 17-20 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-12, and 17-20 have been considered but are moot in view of the new ground(s) of rejection.

i) In view of Applicants arguments the 103 rejection is withdrawn.

ii) The Examiner withdraws the allowable subject matter previously presented in view of a 101

rejection currently presented. This presents a new rejection and therefore this action is **NON-FINAL**.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

MPEP 2106 recites:

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result" State Street 149 F.3d at 1373, 47 USPQ2d at 1601-02. A process that consists solely of the manipulation of an abstract idea is not concrete or tangibles. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed.Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

3. **Claims 1-12, and 17-20 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

i) The Courts have found that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable. As the Supreme Court has made clear, "[a]n idea of itself is not patentable," Rubber-Tip Pencil Co. v. Howard, 20 U.S. (i Wall.) 498, 507 (1874); taking several abstract ideas and

Art Unit: 2128

manipulating them together adds nothing to the basic equation. In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994).

The language of the claims indicate that the claims are directed merely to an abstract idea that is not tied to a technologic art, environment, or machine that would conclude with a tangible result to form the basis of statutory subject matter under 35 USC 101. The claimed "method" appears to be no more than manipulation of data without any application or tangible output, therefore the claims are rejected under 35 USC 101.

ii) As per Gottschalk v. Benson, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972), the claims must result in a physical transformation or provide a "particular machine" for execution. Since the claims show no physical transformation and do not require or state the use of any particular machine the claims fails to provide a statutory result and is therefore rendered non-statutory. See also Diamond v. Diehr 450 U.S. 175, 184 (1981), Parker v. Flook, 437 U.S. 584, 588 n.9 (1978), and Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

iii) Claim 1 merely recites taking data, separating it into smaller portions then randomly outputting it. Claim 17 merely recites nodal manipulation. The Examiner notes that a method claim that recites pure mental steps does not qualify as a statutory process. These claimed limitations clearly do not result in a physical transformation nor are they tied to a particular machine in a manner which would render them statutory. The mere use of a generic computer does not render abstract mental steps statutory.

Appropriate correction is required.

All claims dependent upon a rejected base claim are rejected by virtue of their dependency.

Conclusion

4. Claims 1-12, and 17-20 are rejected.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAIF A. ALHIJA whose telephone number is (571)272-8635. The examiner can normally be reached on M-F, 11:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on (571) 272-2279. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2128

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SAA

/Kamini S Shah/

Supervisory Patent Examiner, Art Unit 2128